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EXAMINER

HOTALING, JOHN M

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 25

Application Number: 08/828,417
Filing Date: March 28, 1997
Appellant(s): MIRASAKI ET AL.

Myron Greenspan
Reg. No. 25,680
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to a remand to the examiner on 11/25/03 from the board of appeals Pursuant to the Remand under 37 CFR 1.193(b)(1) by the Board of Patent Appeals and Interferences on 5/8/03 in order to have a correct copy of claims 25 and 27 on appeal, a supplemental Examiner's Answer is set forth below:

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 23-28 and 39-44 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is not correct. Claims 25 and 27 are not correct and should be as follows and as presented in paper number 11 amendment B entered into the record 4/20/00:

25. A speech outputting game machine according to claim 23, wherein said processing means suspends the output of said phrase data according to a phrase suspension command included in said specific command data.

27. A speech outputting game machine according to claim 23, wherein said command data includes a wild card command; and

wherein said processing means determines and outputs phrase data based on said game progress for the wild card command included in a selected command.

(9) Prior Art of Record

5,735,743	MURATA et al	04-1998
5,695,401	LOWE et al	12-1997
5,393,073	BEST	2-1995
4,333,152	BEST	6-1982
5,712,950	COOKSON et al	1-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 23-28, 31 and 39-44 rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 20.

(11) Response to Argument

With respect to the appellant's misunderstanding of "column 4 lines 25-70" since the column has only 67 lines, and the other instance where a similar error caused confusion, the examiner would like to state that it was his intention to include each and

every line in the column up to and including line 70 and not to cause confusion. The examiner should have stated the last line in the column. The appellant's interpretation of "page 4" as being column 4 is correct. The recitation of "page 5" should also be column 5. While these types of errors have been made in a few instances in the examiners office action it should not render the office action as a whole "internally inconsistent, confusing and, therefore difficult to respond to." Evidence of this is that the appellant correctly understood that the examiner was referring to column 4 not page for in a document which is delineated by column numbers.

With respect to the appellant's arguments that on one hand Murata discloses the use of "alternative phrases" based on the play of the game and then further down the page concedes that Murata lacks in disclosing providing "alternate language commentary" the examiner contends that these are different features provided for in the claims. The alternative phrase are different phrases based on the play of the game as evidenced Murata '743 which gives as an example for the batting scene a combination of the vocal sounds associated with that scene; "STRIKE, BATTER OUT, THREE MEN OUT". With respect to the "alternate language commentary", this is related to different languages (e.g. Japanese, English, French, etc.) as clearly pointed out in the final rejection and hence the incorporation of the Cookson reference which teaches alternative languages. This fact was pointed out in the final office action in the response to arguments section.

The appellant argues that the examiner correctly indicates, in the last paragraph on page 7 of the office action, that he has used a hindsight reconstruction and has

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justified doing so as long as only knowledge within the level of one of ordinary skilled in the art at the time of the invention....etc. The examiner points to the last paragraph of page 7 and the first paragraph of page 8 where the examiner used a form paragraph to obviate the appellant's objection because of hindsight. The examiner clearly pointed out the motivation to combine the references by stating the following : "In this instance the obvious motivation to combine the references is that all of the references are related to the audio placement with respect to the action occurring in the video games and all of the references teach a form of inserting the proper sounds and/or commentary based on the play of the game. This motivation obviates the applicants objection to improper hindsight reasoning."

The appellant argues on page 9 of the brief that Murata does disclose a memory for storing a plurality of announcements and that it is noted that none of the announcements are related to each other in the sense that no two, three, or more, are substantially synonymous and relate to the same game event. Then, further on in the argument, the appellant states that Murata does disclose the use of two announcements that can ostensibly have the same meaning, that the inventors have emphasized that they are not intended to have the same meaning but rather to express a different "nuance": each announcement corresponds to a slightly different "event," or condition of play. The examiner contends that the invention to Murata does indeed provide for a slightly different announcement depending on the play of the game as admitted by the appellant.

With respect to the appellant's arguments on page 10 that Murata preordains the specific verbal statement or audio that is generated the examiner contends that the as claimed instant application also does this as stated in claim 23. Claim 23 states that the instant application selects a specific command data based on predetermined procedures. Murata discloses that it may be preferable to prepare a plurality of groups of vocal sounds having the same word but different intonations or a plurality of vocal sounds having the same meaning and a controller means for designating at least one of the data sets corresponding to one of said vocal sound groups associated with a selected series of said successive game scenes. While Murata may not disclose that his means of selecting is random he discloses that there is a means. In an analogous invention to Lowe, randomization is disclosed with respect to which audio segment is output (see columns 5-7). Since Murata discloses that there may be a plurality of groups of vocal sounds having the same word but different intonations or a plurality of vocal sounds having the same meaning it is obvious and that there is a method to choose which one to use. The use of random numbers to decide an output is taught by Lowe and well known in the computer programming arts. This fact is advantageously taught by the Lowe reference which is capable of random access of all video and audio sequences stored. Furthermore, in Lowe the audio storage requirements are the same as the video storage requirements in that they must have large capacity and random access capability.

With respect to what the secondary references add with respect to the primary feature of the present invention please see the above arguments and all of the office action where the relevance of the secondary references are clearly pointed out.

With respect to the appellant's arguments on page 12 of the brief on "alternative language commentary" please see above.

With respect to the appellant's arguments on page 12 of the brief on "alternative equally appropriate phrases for the same play or identical event" please see above.

With respect to the appellant's arguments on pages 12-13 of the brief on the use of Lowe in the rejection please see above, all of the office actions where the use and intent of Lowe is clearly pointed out. Furthermore Lowe also points out in column 8 that the announcers voice can be deleted and replace with a voice insert by the same announcer. This statement while not specifically supporting multiple announcers it does teach that more than just one announcer has been considered.

With respect to the appellant's arguments on pages 12-13 of the brief on the use of the Best patents in the rejection please see all of the office actions where the use and intent of the Best patents are clearly pointed out.

With respect to the appellant's arguments on page 14 that the examiner has alleged that it would be obvious to use two announcers and to have multiple announcers commenting on a game. The Examiner stated in the office action dated 3/7/02 that the use of two announcers is well known and is an obvious matter of choice well within the capabilities of those skilled in the art since it is common place to have multiple sports announcements for commenting on a game. As proof of the official notice

taken in the 3/7/02 office action please see the article "OT Sports' ABC's Monday Night Football fumbles" dated 10/21/1996 which states that the game is accompanied by commentary from ABC sportscasters Chris Berman, Dan Dierdorf, Frank Gifford, Al Michaels and Lynn Swann.

With respect to the appellant's arguments on page 14 of the brief relative to a plurality of phrases are made to correspond to one single game situation please see above.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, please see above.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to combine the references is clearly pointed out in every office action. The appellant further argues that the examiners motivation is because all of the references "teach the selective use of audio and video games." The examiners motivation for the combination is that all of the references used in the rejection are related to the audio placement with respect to the action occurring in the video games and all of the reference teach a form

of inserting the proper sounds and/or commentary based on the play of the game.

These appellant's statement and the examiner motivation are not analogous.

In response to applicant's argument that the references used in the rejection are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references are all related to the use of audio in video games. In addition please see the paragraph with respect to motivation above.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Respectfully, the examiner notes that the claims as written provide the reader a vague rendering of what the invention is and what it can do. While the use of the terms "may be" and "some of which" in the independent claims do not render the claim indefinite they do make the claim limitations "optional" and more in line with the examiners rejection.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

John M Hotaling II
January 28, 2004



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PRIMARY EXAMINER

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see previous Examiners Answer

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